UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* HAWLEY K. RISING III

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Appeal 2007-0438
Application 09/905,524
Technology Center 2100

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Decided: March 20, 2007

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Before JOSEPH F. RUGGIERO, ALLEN R. MACDONALD and JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

## DECISION ON APPEAL

## STATEMENT OF THE CASE

Appellant appeals from the Examiner's final rejection of claims 1 through 22 pursuant to 35 U.S.C. § 134. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

The Examiner rejects the pending claims as follows:

A. Claims 1 through 22 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of APA and Smith.

The Examiner relies on the following references:

Smith US 6,223,183 B1 Apr. 24, 2001

Applicant's Admitted Prior Art (APA), Specification, pages 1-3

Independent claim 1 is illustrative and representative of the Appellant's invention. It reads as follows:

1. A computerized method for processing descriptions of audiovisual content, the method comprising:

evaluating a description of audiovisual content;

determining whether the description is an abstraction; and

if the description is an abstraction,

determining a level of abstraction, wherein the level of abstraction identifies one of plurality of types of abstraction, and

storing an indicator of the level of abstraction with description of audiovisual content.

Appellant contends that claims 1 through 22 are not unpatentable over the combination of APA and Smith.[1] Particularly, Appellant contends that the cited combination does not fairly teach or suggest a computerized mechanism for evaluating a description of an audio visual content to determine if it is an abstraction as well as to determine the level and type of

[1] This decision considers only those arguments that Appellant submitted in the Appeal Brief. Arguments that Appellant could have made but chose not to make in the Brief are deemed to have been waived. *See* 37 CFR § 41.37(c)(1) (vii)(eff. Sept. 13, 2004). *See also In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

abstraction, as recited in representative claim 1 (Br. 3-4; Reply Br. 2). The Examiner, in contrast, contends that APA teaches the claimed limitation (Answer 3, 7). Consequently, The Examiner concludes that APA, taken in combination with Smith renders claims 1 through 22 unpatentable.

We reverse.

## ISSUES

The *pivotal* issue in the appeal before us is as follows:

(1) Under 35 U.S.C. § 103 (a), would one of ordinary skill in the art, at the time of the present invention, have found that the disclosures of APA and Smith render the claimed invention unpatentable?

## FINDINGS OF FACT

Appellant invented a computer-implemented method and an electronic system for evaluating a description of audiovisual content (Figure 2). Particularly, the invention determines whether the description of an audio visual content is an abstraction. If it is, the invention then identifies the level and type of abstraction. Additionally, the invention stores an indicator of the level and type of identified abstraction in conjunction with the description of the audio visual content (Specification 10).

APA discloses a general overview of descriptions of audiovisual content. Particularly, APA discloses that descriptions of audiovisual content are divided into structural and semantic descriptions. That latter category is further divided into concrete and abstract entities. More particularly, the APA discloses that an abstraction may have one of a plurality of levels, and one of many types (e.g. media abstraction, formal or lambda abstraction) (Specification 2). APA also indicates that no mechanism currently exists to

readily identify a description of an audiovisual content as being an abstraction, as well as to identify the type of abstraction (Specification 3).

Smith discloses an interface for audiovisual content description schemes that indicates how different regions relate to one another. Particularly, Smith discloses how space and frequency view description schemes within multimedia applications can be graphically represented (col. 4, ll. 42-56).

## PRINCIPLES OF LAW

### OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shifts to the Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

## ANALYSIS

As set forth above, Appellant's representative claim 1 requires a computerized mechanism for evaluating a description of an audiovisual content to determine if it is an abstraction as well as to determine the level and type of abstraction. As set forth in the facts section above, APA merely discloses a general overview of descriptions of audiovisual content. However, this overview expressly identifies the shortcomings of the prior art as not having an established mechanism for indicating that a description is an abstraction, and as not being able to identify the type of abstraction. Thus, we find that APA cannot be properly relied upon to teach the claimed limitation when it expressly states that such mechanism is lacking in the prior art. Further, we find that Smith's teaching of graphically representing the relationship between different regions does not cure the deficiencies of APA. After considering the entire record before us, we find that the Examiner erred in rejecting representative claim 1 as being unpatentable over the combination of APA and Smith. We also find for the same reasons that the Examiner erred in rejecting claims 2 through 22 as being unpatentable over APA and Smith.[2]

## OTHER ISSUES

In any further prosecution of the present application, the Examiner should consider rejecting claim 22 under 35 U.S.C. § 101, as not being directed to

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2 Our decision to reverse the Examiner's prior art rejection is based solely on the lack of evidence on the record before us to substantiate the Examiner's contentions. However, our reversal of the rejection should not be construed as an indication that the claims are patentable. We recommend that the Examiner consider US Patent No. 6,735,583 as relevant prior art.

statutory subject matter. Claim 22 recites a computer-readable medium, which Appellants define at page 15 of the Specification to include carrier wave signals.[3]

## CONCLUSION OF LAW

On the record before us, one of ordinary skill in the art at the time of the present invention would not have found that the combination of APA and Smith renders the claimed invention unpatentable under 35 U.S.C. § 103(a).

## DECISION

We reverse the Examiner's decision to reject claims 1 through 22 under 35 U.S.C. § 103(a) as being unpatentable over APA and Smith.

REVERSED

tdl/ce

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3 A case involving this issue is presented on appeal to the Federal Circuit: *In re Nuijten*, No. 06-1301.